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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,587	10/22/2003	Haggai Shoshany	I354SHO-US	3868

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EXAMINER

AFTERGUT, JEFF H

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/689,587

**Applicant(s)**

SHOSHANY ET AL.

**Examiner**

Jeff H. Aftergut

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1-23-06</u> | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-11, 13-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In each of the independent claims the applicant has amended the claims to recite that the lignocellulosic material was not "substantially pretreated with bitumen", however there is no indication that applicant has such in their possession at the time the application was filed.

The applicant argues that because the original disclosure recited that one coated or impregnated paper or foil materials in the known systems that it was clear that the paper of the original disclosure was not treated in such a manner. However, there is no express statement as to what is meant by not substantially pretreating. Does this include some forms of pretreatment with bitumen and not others and to what extent does it include pretreatments. Additionally, there is no clear indication that just because the prior art employed an impregnation operation that the lignocellulosic material of this application was excluded from such treatments. Note that applicant was not in possession of exclusion of the pretreatment as claimed. There simply is not enough evidence from the original disclosure that applicant was in possession of the lack of the

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pretreatments with bitumen. It should be noted that it was only in hindsight when faced with the prior art applied by the Office that applicant preceded to recite the exclusion of the pretreatment with bitumen. As such, it is deemed to be new matter.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-11, and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant has added to each of the independent claims that the lignocellulosic material was not "substantially pretreated with bitumen". However, the original disclosure gives no guidance as to what is meant by "not having been substantially pretreated with bitumen". In other words, it is not known what kinds of pretreatments are acceptable and within the meaning of not having been substantially pretreated with bitumen. Can bitumen be present in the paper webs prior to the use of the adhesive? The exact scope of the claim cannot be ascertained because the claims are not deemed to be clear and concise.

#### ***Claim Rejections - 35 USC § 102***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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6. Claims 10 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Wandel '281 for the same reasons as expressed in paragraph 2 of the Office action dated 10-27-05.

Regarding the limitations added to the claim requiring the lack of a pretreatment of the paper with bitumen, the reference to Wandel '281 does not pretreat the paper material with bitumen. The reference taught that one applied an oil coating to the web 12 like linseed oil or fish oil in order to soften the same to facilitate corrugation but there is no pretreatment with bitumen described in the reference and in fact that paper webs 18 and 24 are merely treated with bitumen which was used as the adhesive to make the corrugated board therein and not pretreatment with bitumen is disclosed in the reference.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1, 3-4, 6, 11, 13-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller (US 1,878,452) in view of Keller (US 1,924,609, newly cited).

Keller '452 is discussed at length in paragraph 3 of the Office action dated 10-27-05. The applicant is referred to the same for a complete discussion of the reference. Keller '452 taught that it was known to form a tubular article via a winding operation wherein the operation was either convolutedly winding of spirally winding. The reference taught that the material being wound included a felt which was formed from bituminous pulps which included both bituminous materials and waste papers (lignocellulosic

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materials). The reference taught that one skilled in the art would have applied asphalt as an adhesive material to join the layers of spirally wound or convolutedly wound materials together. The applicant is more specifically referred to page 1, lines 48-66 (where the use of papers in the felt are described, one skilled in the art readily understanding that waste papers are lignocellulosic materials) and page 2, lines 26-67 (for the manufacture of the tubes with the bituminous felt where the binder used to join the felts together was an asphalt). While the lignocellulosic felt (bituminous felt) was not pretreated with bitumen, to the extent that it already had bitumen in it, the reference might be construed as having a paper layer which included a pretreatment with bitumen. However, one skilled in the art would have understood that lignocellulosic materials which did not contain bitumen pretreatment therein were known in the art as evidenced by Keller '609.

Keller '609 suggested that those skilled in the art at the time the invention was made would have known to wind a container wherein the web material utilized which was joined with bituminous material included either the bituminous felt of Keller '452 or any other type of lignocellulosic paper material, see page 1, line 107-page 2, line 19. Clearly, one skilled in the art would have understood that the processing performed by Keller '452 would have included processing papers which were not just bituminous felts but also included just lignocellulosic webs therein. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize mere paper webs in the processing of Keller '452 as such was suggested as known in the art of making wound containers as suggested by Keller '609.

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9. Claims 1, 3-4, 6, 10, 12-13, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wandel '281 in view of applicant's admitted prior art and Keller '452 for the same reasons as expressed in the Office action dated 10-27-05, paragraph 5 optionally further taken with Keller '609 (newly cited).

The reference to Wandel '281 clearly (as discussed above) did not include a pretreatment with bitumen in the operation and in fact the pretreatment of the web for softening the same to facilitate corrugation of the web. The references thus satisfy the claims as presented. It should be noted that one could interpret Keller '452 as being inclusive of a pretreatment step, however, as expressed above, the use of a web of paper which was not a bituminous felt was known in the art as evidenced by Keller '609.

Keller '609 suggested that those skilled in the art at the time the invention was made would have known to wind a container wherein the web material utilized which was joined with bituminous material included either the bituminous felt of Keller '452 or any other type of lignocellulosic paper material, see page 1, line 107-page 2, line 19. Clearly, one skilled in the art would have understood that the processing performed by Keller '452 would have included processing papers which were not just bituminous felts but also included just lignocellulosic webs therein. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the asphalt bituminous adhesives of Wandel '281 in the manufacture of a tubular article which was wound from paper layers as it was known as suggested by applicant's admitted prior art to utilize the same adhesives for both corrugated board as well as formation of spirally wound or convolutedly wound tubes as further evidenced by Keller '452 wherein it was

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known in the winding art to utilize any kind of paper and not only bituminous felts as evidenced by Keller '609.

10. Claims 5, 7-9, 15, and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as set forth above in paragraph 9 further taken with Bosniack for the same reasons as expressed in paragraph 6 of the Office action dated 10-27-05.

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1, 3-11 and 13-20 have been considered but are moot in view of the new ground(s) of rejection.

It should be noted that the language relating to the absence of any substantial pretreatment with bitumen is deemed not to be supported by the original disclosure and therefore is believed to not have been in applicant's possession at the time the application was filed. Additionally, as applicant failed to describe the absence or substantial absence of bitumen in the lignocellulosic material prior to the use of the adhesive, it is not clear what the exact scope of this language is.

Regarding Wandel '281, it is clear from the reading of the same that the paper webs which were coated with the bitumen in the bonding operation where the paper was not pretreated with any kind of coating prior to coating with bitumen which was used as an adhesive in the operation. The oil coating referred to by applicant is for the purpose of facilitating the softening of a web so that the web is capable of being



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corrugated. Clearly, one skilled in the art viewing Wandel '281 would have understood the same.

As to the reference to Keller '452, applicant is advised that one skilled in the art would have understood that the use of bitumen as an adhesive for a paper web which was not a bituminous felt was readily understood by the artisan as evidenced by Keller '609 (newly cited). Applicant's arguments to the contrary have not been found to be persuasive therefore.

### ***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

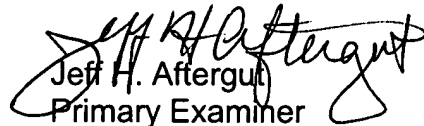
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeff H. Aftergut  
Primary Examiner  
Art Unit 1733

JHA  
February 22, 2006